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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FABIO GIANNETTI

Appeal 2009-007347
Application 10/668,207
Technology Center 2400

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-21, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

Appellant's invention relates to a method of delivering data to one or more data-handling devices. Data intended for transmission to the data-handling device is stored according to a predetermined template which provides a plurality of fields, each of the fields being capable of containing a portion of the data. Mappings that map the data within the fields of the predetermined template to fields within alternative templates are provided, should it be determined that the data-handling device is not capable of handling data held in the predetermined template. The data is transmitted to the data-handling device. Abstract.

Representative Claim

16. A method of delivering data to at least one data-handling device, the method comprising the steps of:

- i. storing data that is intended for transmission to the data-handling device in one of a plurality of predetermined templates each of which provides a plurality of fields and each of the fields being capable of containing a portion of the data;
- ii. storing a plurality of mappings that map data held within a field of one of the predetermined templates to fields within an alternative template should it be determined that the

data-handling device to which the data is to be sent is not capable of handling data held in the predetermined template;

iii. altering the data according to one of the mappings should it be determined that the data-handling device cannot handle the data; and

iv. transmitting the data to the data-handling device.

Examiner's Rejections

Claims 12-15 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1-5, 7, 9-16, and 19-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Slaughter (US 6,898,618 B1).

Claims 6, 8, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Slaughter and Horvitz (US 6,980,993 B2).

Claim Groupings

In view of Appellant's arguments in the Appeal Brief, we will decide the appeal on the basis of claim 12 for the non-statutory subject matter rejection, and claim 16 for the prior art rejections. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

(1) Has Appellant shown that a "computer-readable medium" as recited in claim 12 does not encompass non-statutory subject matter?

(2) Has Appellant shown that Slaughter does not describe "storing a plurality of mappings" and "altering the data" as recited in claim 16?

FINDINGS OF FACT

1. Slaughter describes a mechanism for a client to specify a display service for displaying results data. Title; Abstract.
2. The results data can be stored as XML objects in a space. Col. 96, ll. 66 to col. 97, ll. 15.
3. Each space has an XML schema that is capable of being used by most clients, including devices such as PDAs. Col. 43, ll. 39-58.
4. Two or more presentation schemas may be provided for formatting and displaying the same results data on different displays. For example, one presentation schema can be provided for displaying the results data on a display screen, and another for printing the results data. Col. 86, ll. 18-21 and 47-62.
5. The results data includes a plurality of data elements, and the presentation schema includes a plurality of presentation elements. The display service maps the data elements to the presentation elements. Col. 87, ll. 47-62.

PRINCIPLES OF LAW

Statutory Subject Matter for Computer Readable Media

The USPTO is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. *See In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible

media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. *See* MPEP § 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter).

Anticipation

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

ANALYSIS

Section 101 rejection of claims 12-15

Claim 12 recites a computer readable medium. Although Appellant contends that he disclaims any interpretation of “computer readable medium” that covers a transmitted signal (Br. 9), claim 12 does not limit the computer readable medium to non-transitory tangible media. In addition, Appellant’s Specification states that the computer readable medium may be “a transmitted signal (which may be an Internet download, a ftp transfer, or any other transmitted signal)” (Spec. 8:24-28). The computer readable medium therefore encompasses a transitory, propagating signal, which is not a process, machine, manufacture, or composition of matter. *Nuijten*, 500 F.3d at 1357.

Claim 12 “covers material not found in any of the four statutory categories [and thus] falls outside the plainly expressed scope of § 101.” *Id.* at 1354. Appellant has not presented arguments for separate patentability of dependent claims 13-15. Claims 13-15 thus fall with claim 12.

Prior Art Rejections of claims 1-21

Appellant contends that Slaughter does not disclose “storing a plurality of mappings that map data held within a field of one of the predetermined templates to fields within an alternative template should it be determined that the data-handling device to which the data is to be sent is not capable of handling data held in the predetermined template” as recited in claim 16. Br. 10. The Examiner finds that Slaughter describes storing data in an XML template, then re-mapping the stored data to a different XML template as dictated by the capabilities of the data handling device. Ans. 15.

We agree with the Examiner. Slaughter describes storing results data in a space. FF 2. Each space has an XML schema, or “template,” that can be used by most clients. FF 3. The results data can also be mapped to alternative XML templates to display the same results data on different display devices. FF 4-5.

The space with an XML template that stores the results data is “one of a plurality of predetermined templates” within the meaning of claim 16. The different presentation templates for formatting data to different display devices are “a plurality of mappings that map data held within a field of one of the predetermined templates to fields within an alternative template should it be determined that the data-handling device to which the data is to

be sent is not capable of handling data held in the predetermined template” within the meaning of claim 16.

Appellant further contends that Slaughter does not disclose “altering the data according to one of the mappings should it be determined that the data-handling device cannot handle the data” as recited in claim 16. Br. 10. In the Summary of Claimed Subject Matter section of the Brief, Appellant points to support for the “altering the data” limitation on page 15, lines 23-26 of the Specification, which states that if the device cannot handle the data, the data is mapped to the appropriate alternative template.

Slaughter describes mapping data stored in an XML template to an alternative template so that a display device can display the results. FF 1-5. Therefore, Slaughter describes “altering the data according to one of the mappings should it be determined that the data-handling device cannot handle the data” within the meaning of claim 16.

Appellant has not presented arguments for separate patentability for the remaining claims, but instead relies on the arguments presented for claim 16. Therefore, claims 2-15 and 17-21 fall with claim 16.

CONCLUSIONS OF LAW

(1) Appellant has not shown that a “computer-readable medium” as recited in claim 12 does not encompass non-statutory subject matter.

(2) Appellant has not shown that Slaughter does not describe “storing a plurality of mappings” and “altering the data” as recited in claim 16.

DECISION

The rejection of claims 12-15 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is affirmed.

The rejection of claims 1-5, 7, 9-16, and 19-21 under 35 U.S.C. § 102(e) as being anticipated by Slaughter is affirmed.

The rejection of claims 6, 8, 17, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Slaughter and Horvitz is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

msc

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